



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,724	02/27/2001	Laurent Mollard	06569/0212	3719

22428 7590 08/13/2003

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

MOHAMED, ABDEL A

ART UNIT PAPER NUMBER

1653

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/763,724	MOLLARD ET AL.	
	Examiner	Art Unit	
	Abdel A. Mohamed	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

ACKNOWLEDGMENT FOR PRIORITY, PRELIMINARY AMENDMENT, IDS, STATUS OF THE APPLICATION AND CLAIMS

1. This application is filed under 35 U.S.C. 371 on 02/27/01 having a filing date of 08/27/99 of PCT/FR99/02052. Acknowledgment is made of Applicant's claim for priority based on French Application Number 9810868, having filing date of 08/31/98. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file. The preliminary amendment, information disclosure statement (IDS) and Form PTO-1449 filed 2/27/01 are acknowledged, entered and considered. In view of Applicant's request claims 4 and have been amended. Thus, claims 1-6 are present for examination.

ABSTRACT MISSING

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

CLAIMS REJECTION-35 U.S.C. § 102(b)

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Moore (U.S. Patent No. 5,637,321).

The reference of Moore discloses extraction of cartilage of avian origin having active ingredient such as Type II collagen, which is useful in medical application (See e.g., abstract, col. 3 and Example 1). The cartilage is obtained and/or extracted by different method as disclosed in Example 1 of the reference; however, claims 5 and 6 are not limited to the manner of separation and extraction claimed. Thus, claims 5 and 6 are presented in product-by-process format, and as such, it is the novelty and patentability of the instantly claimed product that need be established and not the recited process steps, *In re Brown*, 173 USPQ 685 (CCPA 1972); *In re Wertheim*, 191 USPQ (CCPA 1976). Further, the prior art described the product as old, *In re Best*, 195 USPQ 430, 433 (CCPA 1977); (See MPEP 706.03 [e]). Hence, the burden of proving that the process limitation makes a different product is shifted to Applicants. *In re Fitzgerald*, 205 USPQ 594. Hence, in the absence of evidence to the contrary or specific structural limitations, the claimed formulation/product disclosed by the reference anticipates claims 5 and 6 as drafted.

CLAIMS REJECTION-35 U.S.C. § 103(a)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (U.S. Patent No. 5,637,321) taken with Lin (U.S. Patent No. 5,384,149).

Moore teaches similarly as the instantly claimed invention method for separating and extracting cartilages from avian origin, preferably chicken cartilage. The separated and extracted cartilages are diced or otherwise comminuted by means known in the art desirably into particles no larger than a dose in the amount of at least about 0.01 gram and preferably from about 0.1 to about 0.5 of grams of chicken cartilage which can be used to obtain type II collagen and as such meeting the limitations of obtaining particle size of less than about 1 cm. (See e.g., col. 2, lines 24 to 62) as directed in claims 1 and 4-6. Note that the reference cites in grams while the claim cites in centimeters, however, since 1 gram = 1 cm, 0.01 gram = 0.01 cm, and similarly 0.1 to 0.5 grams = 0.1 to 0.5 cms, and as such, the units recited in the reference is less than about 1 cm.

Moore differs from claims 1-6 in not teaching the use of a water-soluble separating vessel having an ascending vertical component and wherein the separating liquid is water or an edible brine (alt solution such as NaCl). Although, the reference of Moore does not teach the separation and extraction of cartilages from ground poultry

skeleton by a flow of edible liquid circulating in a separating vessel, however, the reference clearly teaches the blending process which includes mixing and/or blending of cartilages by using a blender. Thus, the use of a blender is a clear indication that the extracted cartilage is processed in a separating vessel having an ascending vertical component (See e.g., col. 3 and Example 1) as directed to claims 1 and 2. With respect to the general method wherein the separating liquid is water or an edible brine; however, the general method of separating liquid is water or a salt solution is conventional and within the ordinary skill in the art to which this invention pertains to use water for separating liquid or salt solutions for the intended purposes of obtaining and/or recovering of any cartilage of interest. Nevertheless, wherein water is used for separating liquid or salt solution is clearly disclosed by the secondary reference of Lin, on col. 2, lines 32-44 and Figure 1, as directed to claim 3. The reference clearly states that animal carcass by-product (i.e., bone by-product) are collected in a sanitary manner and comminuted. Comminuted by-products are mixed with water and salt at a predetermined ionic strength to dissolve salt soluble proteins. Thus, clearly showing that the separating liquid is water or an edible brine.

Therefore, in view of the above, one of ordinary skill in the art would have been motivated to adapt the well known general method wherein the separating liquid is water or an edible brine scheme of Lin's secondary reference into the method of Moore's primary reference because including such features into the method of Moore's reference would have been obvious to one of ordinary skill in the art to obtain the known and recognized functions and advantages of using water for separating liquid or salt solution thereof. With respect to claims 5 and 6, the claims are in product-by-process format, and as such, it is the novelty and patentability of the instantly claimed product that need be established and not the recited process steps, *In re Brown*, 173 USPQ 685

(CCPA 1972); *In re Wertheim*, 191 USPQ (CCPA 1976). Further, the prior art described the product as old, *In re Best*, 195 USPQ 430, 433 (CCPA 1977); (See MPEP 706.03 [e]). Hence, the burden of proving that the process limitation makes a different product is shifted to Applicants. *In re Fitzgerald*, 205 USPQ 594. Therefore, the combined teachings of the prior art makes obvious a method for separating and extracting cartilages of avian origin, wherein the cartilages are separated and extracted from ground poultry skeletons by flow of edible liquid circulating in a separating vessel and to active ingredient products thereof, absence of sufficient objective factual evidence or unexpected results to the contrary.

CONCLUSION AND FUTURE CORRESPONDANCE

5. No claim is allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed whose telephone number is (703) 308-3966. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00 p.m. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S.F. Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-7401 for After Final communications.

Application/Control Number: 09/763,724
Art Unit: 1653

Page 7

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

 Mohamed/AAM

August 8, 2003


CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600